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West v. Mead Data Central: Has Copyright Protection Been Stretched Too Far

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West v. Mead Data Central: Has Copyright Protection Been Stretched Too Far?

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Introduction

Users of Lexis[1] will not find pinpoint cites[2] to page numbers in West's reporters. In a decision that has raised some eyebrows in the legal community,[3] the Eighth Circuit held that Mead Data Central's (MDC) case retrieval system, LEXIS, probably infringes on the copyright of West Publishing's case reporters by including West's page numbers in its database.[4]

The decision raises important questions about the extent of copyright protection. For example, the Arabic number system is not copyrightable,[5] and neither are judicial opinions.[6] How-

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1. LEXIS is the computer-assisted research system created by Mead Data Central (MDC).

2. Pinpoint cites, also called jump cites or star pagination, are page breaks within the text that indicate where that part of the text can be found in another reporter. West Publishing Co. v. Mead Data Central, Inc., 799 F.2d 1219, 1222 (8th Cir. 1986), *cert. denied*, 107 S.Ct. 962 (1987). Pinpoint cites are especially important for lawyers, law students, paralegals and judges, since the pinpoints direct the reader to the exact location of cited text in a reporter. In addition, pinpoint cites are required in briefs and other papers filed with most courts.

3. Reidinger, *Cite Wars: Lexis Can't Use West's Pages*, 72 A.B.A.J. 78 (1986).

4. West Publishing Co. v. Mead Data Central, Inc., 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 107 S.Ct. 962 (1987).

5. *Id.* at 1227 ("two always comes after one, and no one can copyright the mere sequence of Arabic numbers"). *See also* Callaghan v. Meyers, 128 U.S. 617 (1888). As counsel for Defendant Callaghan said:

> Ever since the invention of printing, books have been paged in numerical order, and appellee might with equal propriety claim an exclusive property in the system of Arabic numerals as in the paging of his books. Moreover, the printed paging is merely the mechanical labor of the printer, and is never performed by the author or publisher.

Id. at 641 (Mr. J. L. High for Defendant Callaghan).

6. Wheaton v. Peters, 33 U.S. (8 Pet.) 591 (1834); Rand McNally & Co. v. Fleet Management Sys., 591 F. Supp. 726, 735 (N.D. Ill. 1983).

ever, compilations of judicial opinions are copyrightable.[7] Was the court correct in finding that West's copyright in the compilations extended to include the page numbers?[8] Is the decision consistent with the goals of copyright? Does the opinion reveal the inadequacies of the Copyright Act in dealing with the overlap between new and old ways of disseminating information?[9]

This note addresses the questions raised by *West v. MDC*. Part I gives a brief overview of copyright law, including four cases that the Eighth Circuit discussed. Part II examines the opinions of the district court, the Eighth Circuit, and the separate opinion of Judge Oliver.[10] Part III discusses three possible ways to change the result of *West v. MDC*.

I
The Facts

West publishes volumes of court opinions which it calls its National Reporter System.[11] The volumes contain helpful features such as indices, tables, names of counsel, synopses of the cases, and headnotes with references to West's Keynote Numbering System.[12]

MDC does not publish case reporters, but it has a computer-assisted legal research system called LEXIS.[13] LEXIS allows

7. 17 U.S.C. § 103 (1976). *See infra* notes 24-53 and accompanying text.

8. The District Court said that "West's page numbers and its arrangement of cases are necessarily within the scope of copyright protection." West Publishing Co. v. Mead Data Central, Inc., 616 F. Supp. 1571, 1577 (D. Minn. 1985). *Cf. West*, 799 F.2d at 1237 (opinion of Oliver, J.). The Eighth Circuit held that "the copyright we recognize here is in West's arrangement, not in its numbering system; MDC's use of West's page numbers is problematic because it infringes West's copyrighted arrangement, not because the numbers themselves are copyrighted." *Id.* at 1228.

9. *See West*, 616 F. Supp. at 1578.

10. The separate opinion of Judge Oliver was twice as long as the majority opinion of Judge Arnold. While some of the separate opinion concerns procedure, see *id.* at 1230-31, the remainder concerns copyright.

11. These are well-known in the legal profession: Supreme Court Reporter, Federal Reporter, Federal Supplement, California Reporter, New York Supplement, North Eastern Reporter, et al. For a complete listing, see WEST'S LAW FINDER: A REASEARCH MANUAL FOR LAWYERS 5-10 (rev. ed. 1985).

12. Key Number Digests are indices published by West. The Key Number is a fixed number given to a specific point of case law, such as Intoxicating Liquors Key Number 285. Attorneys can go to the Key Digests under that heading and find other cases that deal with the subject.

Generally speaking, "[a] complete report of a decided case usually includes the syllabus or headnote; the names of the respective counsel . . . the statement of the case . . . and the opinion of the court." 77 C.J.S. *Reports* § 2 (1982).

13. *See supra* note 1. As MDC states, LEXIS is a versatile research tool: "LEXIS

users to review court opinions and statutes on a computer. MDC announced that it planned to include page numbers from West's reporters in its database, enabling its users to know exactly where the text on the screen could be found in West's reporters.[14] Thus, LEXIS users would be able to research through LEXIS instead of West's reporters, but still be able to give pinpoint cites to West's reporters. MDC called its proposed service "star pagination."[15]

When West heard about MDC's intentions, it sought a preliminary injunction in the U.S. District Court of Minnesota.[16] The District Court granted the injunction[17] and MDC appealed. The Eighth Circuit affirmed, finding that MDC's use of the page numbers probably infringed on West's copyright.[18] John W. Oliver, Senior District Judge, filed a separate opinion concurring with the procedural analysis but dissenting from the majority's view of the copyright issues.[19]

II
General Copyright Law

A. Historical Background

Ages before Sir William Blackstone published his famed Commentaries,[20] the Irish King Diarmed settled a dispute between Abbot Fennian and St. Columba over the latter's copying of the Abbot's Psalter, finding for the Abbot and declaring "to every cow her calf."[21] This is the essential tenet of copyright law: the author or originator of certain literary works or artistic productions has a vested right to make copies of the works, publish them, and sell them.[22]

. . . can do research impossible by any other means. Here's an example . . . . Of all law review articles on LEXIS . . . which has the most footnotes? The solution . . . is quick, startlingly simple, and makes effective use of LEXIS' literalism." Great Lexpectations: Mead Data Central's Newsletter for Law Schools, Dec. 1984, at 1. LEXIS' chief competitor is Westlaw, West Publishing's computer-assisted research system.

14. *West*, 799 F.2d. at 1222.

15. *Id.*

16. *West*, 616 F. Supp. at 1571.

17. *Id.*

18. *West*, 799 F.2d at 1219.

19. *Id.* at 1230.

20. W. BLACKSTONE, COMMENTARIES ON THE LAWS OF ENGLAND IN FOUR BOOKS (Tucker ed. 1803).

21. W. PATRY, LATMAN'S THE COPYRIGHT LAW 2 (6th ed. 1986).

22. Harper & Row, Publishers v. Nation Enterprises, 471 U.S. 539, 547 (1985).

American copyright law is a direct descendant of English law,[23] particularly the Statute of Anne.[24] The Statute of Anne, the first statute concerned exclusively with copyright,[25] was also the first to recognize specifically the rights of authors.[26]

Federal power to enact copyright statutes is expressly provided by the Constitution.[27] The first U.S. copyright statute was the Copyright Act of 1790.[28] Numerous revisions and amendments took place over the next century[29] until the Copyright Act of 1909.[30] The 1909 Act was the product of several years of painstaking effort and "discussion on the part of every interest involved, including eminent members of the bar."[31] The 1909 Act was in turn replaced by the Copyright Act of 1976,[32] which greatly simplified the trigger mechanism for protection of works[33] and was intended to be flexible enough to accommodate new technologies such as computer programs and electronic databases.[34] Amendments to the 1976 Act have at-

23. W. PATRY, *supra* note 21, at 2. Professor Patry gives a clear synopsis of the history of copyright, including tidbits from Blackstone, Venetian decrees, Catholic Queen Mary and the "Stationer's Company," the Star Chamber, and the Statute of Anne. *See id.* at 2-5.

24. 8 Anne ch. 19 (1710). The full title is *An Act for the Encouragement of Learning, by Vesting the Copies of Printed Books in the Authors or Purchasers of such Copies, during the Times therein mentioned. See* H. RANSOM, THE FIRST COPYRIGHT STATUTE 3, 109 (1956).

25. H. RANSOM, *supra* note 24, at 3.

26. W. PATRY, *supra* note 21, at 4.

27. U.S. CONST. Art. I, § 8, cl. 8 states in pertinent part:

The Congress shall have Power . . . [t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries. *Id.*

28. Act of May 31, 1790, 1 Stat. 124 (1790) (repealed 1831). Like the Statute of Anne, the Act had certain formalities and restrictions, such as recording title prior to publication and depositing a copy of the work. *See* W. PATRY, *supra* note 21, at 6.

29. *See, e.g.*, Act of April 29, 1802, 7th Cong., 1st Sess., 2 Stat. 171 (1802) (repealed 1819); Act of February 3, 1831, 21st Cong., 2d Sess., 4 Stat. 436 (1831).

30. 17 U.S.C. § 1 et seq. (1909) (repealed 1978).

31. W. PATRY, *supra* note 21, at 9.

32. 17 U.S.C. §§ 101-18 (1976) [hereinafter 1976 Act].

33. The 1909 Act would protect a work upon publication, whereas the 1976 Act protects a work upon fixation. *Compare* 1909 Act, *supra* note 30, at § 2 (preserving common law rights for unpublished works, inferring lack of protection under statute); *with* 1976 Act, *supra* note 32, at §§ 101, 102 (a work must be fixed in a "tangible medium of expression"). In other words, once a person creates an original work, the 1976 Act protects it; the same person would have had to publish the work in order to get protection from the 1909 Act. Thus, the anomoly that a playwright who had his play performed was not protected by the 1909 Act unless the script was published.

34. New technology poses some problems for copyright law:

While copyright has traditionally concerned itself with the craft of the author, composer, and artist, present-day copyright disputes are increasingly

tempted to keep copyright law current with technological advances.[35]

B. Copyright for Compilations

The Copyright Act of 1976 expressly extends protection to compilations.[36] A compilation is a work that is "formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship."[37] Compilations include "collective works," such as anthologies or encyclopedias.[38] Thus, phone books[39] and case reporters[40] are copyrightable compilations, but the production, arrangement and flow of a Christmas parade is not.[41] While the names and addresses of a phone book are not copyrightable per se,[42] the book itself, an original work formed by the industrious collection, selection, organization, and arrangement of material,[43] is copyrightable and protectable as a compilation.[44]

"Copyright law and compilations are uneasy bedfellows."[45]

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likely to involve computer programs, electronic data bases, and the transmission or reception of copyrighted works by satellite, microwave, and a host of other new technological marvels. With increasing frequency, the courts are being asked to fit these new technological uses into a copyright act which, while designed to be flexible in order to accommodate such new technologies, is nevertheless occasionally unequal to the task a mere seven years after its general effective date.

W. PATRY, *supra* note 21, at 1.

35. *E.g.*, The Semiconductor Chip Protection Act of 1984, Pub. L. No. 98-620, 98 Stat. 3347 (codified at 17 U.S.C. §§ 901-14) (1986) (expressly extending copyright protection to include "semiconductor chip products" and "mask works").

36. "The subject matter of copyright as specified by section 102 includes compilations and derivative works. . . ." 1976 Act, *supra* note 32, at § 103(a).

37. *Id.* at § 101.

38. *Id.*

39. Hutchinson Tel. Co. v. Fronteer Directory Co., 770 F.2d 128 (8th Cir. 1985), *reversing* 586 F. Supp. 911 (D.C. Minn. 1984); Southern Bell Tel. & Tel. Co. v. Associated Tel. Directory Publishers, 756 F.2d 801 (11th Cir. 1985).

40. Wheaton v. Peters, 33 U.S. (8 Pet.) 591 (1834); Banks Law Publishing Co. v. The Lawyers' Co-operative Publishing Co., 169 F. 386 (2d Cir. 1909) (discussed *infra* notes 98-104 and accompanying text); *see also West*, 799 F.2d at 1224.

41. Production Contractors, Inc. v. WGN Continental Broadcasting Co., 622 F. Supp. 1500 (N.D. Ill. 1985).

42. Harper & Row, Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 556 (1985) ("no author may copyright his ideas or the facts he narrates").

43. Jeweler's Circular Publishing Co. v. Keystone Publishing Co., 281 F. 83 (2d Cir. 1922).

44. Cooling Sys. and Flexibles, Inc. v. Stuart Radiator, Inc., 777 F.2d 485, 492 (9th Cir. 1985). *See also* 1976 Act, *supra* note 32, at § 103(a).

45. Eckes v. Card Prices Update, 736 F.2d 859, 862 (2d Cir. 1984).

Affording copyright protection to a Shakespearean sonnet seems more justifiable than protecting a phone book.[46] The Constitution grants Congress the power to make copyright statutes in order "[t]o promote the Progress of Science and useful Arts,"[47] and some courts have taken the phrase to mean that a work must contain some substantial creativity or novelty.[48] Nevertheless, novelty "has nothing to do with the validity of the copyright."[49] Originality is the only requirement.[50]

C. Fair Use

The 1976 Act codified the judicial doctrine of fair use,[51] one of the most important and well-established limitations on the exclusive rights of copyright.[52] Fair use is the idea that some material, though protected by copyright, may be used by others in a reasonable manner without the consent of the copyright holder.[53] The doctrine, as an equitable rule of reason, is not

46. Since Shakespeare's work is almost 400 years old, it is in the public domain and can be used by anyone. *See, e.g.*, 1976 Act, *supra* note 32, at § 302 (a copyright exists for the life of the author plus 50 years). The District Court, the Eighth Circuit majority, and the separate opinion all refer to Shakespeare. *See West*, 799 F.2d at 1235 n.17. The majority thought that invoking Shakespeare would demonstrate the value of protecting case compilations: "An arrangement of opinions in a case reporter, no less than a compilation and arrangement of Shakespeare's sonnets, can qualify for copyright protection." *Id.* at 1224.

47. U.S. CONST. Art. I, § 8, cl. 8.

48. "Obviously, the Constitution does not authorize such a monopoly grant to one whose product lacks all creative originality. . . . Plaintiff therefore must lose unless he has shown that his work contains some substantial, not merely trivial, originality . . . ." Chamberlin v. Uris Sales Corp., 150 F.2d 512, 513 (2d Cir. 1945); *cf.* Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 251 (1903) (Mr. Justice Holmes cautioned against judging the "worth" of works.).

For a thorough refutation of the view that this clause limits protection of obscene, immoral, or merely amusing original works, see 1 M. NIMMER, NIMMER ON COPYRIGHT § 103[B] (1986).

49. Baker v. Selden, 101 U.S. 99, 102 (1879).

50. 1976 Act, *supra* note 32, at § 102. Original means that the work "owes its origin" to the "author." Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 57-58 (1884); Toro Co. v. R & R Prods. Co., 787 F.2d 1208, 1213 (8th Cir. 1986).

The requirement for originality is very low. For example, in determining whether one person's version of a subject contains sufficiently distinguishable variations from another's version, it is enough that "a shock caused by a clap of thunder" caused the second to inadvertently vary from the original. Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 105 (2d Cir. 1951) (opinion by Frank, J.); *see also* L. Batlin & Sons v. Snyder, 536 F.2d 486, 490 (2d Cir.) (en banc), *cert. denied*, 429 U.S. 857 (1976).

51. 1976 Act, *supra* note 32, at § 107. The concept was named "fair use" in Lawrence v. Dana, 15 F. Cas. 26, 60 (C.C.D. Mass. 1869) (No. 8, 136).

52. N. BOORSTYN, COPYRIGHT LAW 312, § 10:27 (1981).

53. *See* H. BALL, LAW OF COPYRIGHT AND LITERARY PROPERTY 260 (1944), *cited in* Harper & Row, Publishers v. Nation Enterprises, 471 U.S. 539, 549 (1985).

readily susceptible to a real definition, and no general definition has emerged.[54] Indeed, its equitable virtue is also its vice: no less an authority than Judge Learned Hand[55] agreed that the fair use doctrine is "the most troublesome in the whole law of copyright."[56]

Strictly speaking, the 1976 Act does not attempt to define fair use: it lists "factors to be considered" for the purpose of "determining whether the use made of a work in any particular case is a fair use."[57] Those factors include the purpose and character of the use, the nature of the work itself, the amount of the work used, and the effect on the work's market or value.[58]

The courts have not satisfactorily defined fair use either, but certain tendencies are apparent. Generally, using an insubstantial amount of a copyrightable work is fair.[59] When copyrighted material is used in a commercial context, such as in an advertisement or by a competitor, courts have been unwilling to find

54. N. BOORSTYN, *supra* note 52, at 313. One court has said, "The [fair use] doctrine is entirely equitable and is so flexible as virtually to defy definition." Time, Inc. v. Bernard Geis Assocs., 293 F. Supp. 130, 144 (S.D.N.Y. 1968).

55. Judge Hand has written the opinions of many important copyright cases, including Nichols v. Universal Pictures Corp., 45 F.2d 119 (2d Cir. 1930), *cert denied*, 282 U.S. 902 (1931); Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49 (2d Cir. 1936); and Fred Fisher, Inc. v. Dillingham, 298 F. Supp. 145 (S.D.N.Y. 1924).

56. Dellar v. Samuel Goldwyn, Inc., 104 F.2d 661, 662 (2d Cir. 1939) (per curiam opinion of L. Hand, Augustus N. Hand, and Patterson, JJ.).

57. 3 M. NIMMER, NIMMER ON COPYRIGHT § 13.05[A] (1986), *citing* 1976 Act, *supra* note 32, at § 107.

58. 1976 Act, *supra* note 32, at § 107. The section reads in full:

> Sec. 107. Limitations on Exclusive Rights: Fair Use
>
> Notwithstanding the provisions of section 106, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include —
>
> (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
>
> (2) the nature of the copyrighted work;
>
> (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
>
> (4) the effect of the use upon the potential market for or value of the copyrighted work.

Id.

59. In an article about the history of the Green Bay Packers, verbatim use of the chorus of the official fight song, "Go! You Packers, Go!" was a fair use. Karll v. Curtis Publishing Co., 39 F. Supp. 836 (E.D. Wis. 1941). Similarly, fair use was found when a political commercial on television used a portion of the plaintiff's song. Keep Thomson Governor Comm. v. Citizens for Gallen Comm., 457 F. Supp. 957 (D. N.H. 1978).

a fair use.[60] In addition, use of creative material, as opposed to factual material, is often found to infringe on the copyright.[61]

III
The Key Cases

A. *Wheaton v. Peters*: The Highest Court Articulates the Goals of Copyright

Wheaton v. Peters[62] was the first significant United States Supreme Court copyright case.[63] Henry Wheaton, reporter of the Supreme Court from 1816 until 1827, sued Richard Peters, reporter of the Supreme Court from 1827 to 1843, for selling a condensed version of the Supreme Court's opinions which included reports gathered during Wheaton's term.[64] In holding that Peters did not infringe upon Wheaton's copyright, the court said:

> It may be proper to remark that the court are unanimously of opinion, that no reporter has or can have any copyright in the

60. The commercial inquiry flows from the 1976 Act: "[F]actors to be considered shall include . . . whether such use is of a commercial nature." 1976 Act, *supra* note 32, at § 107(1). Thus, advertising is less likely to get fair use protection due to its commercial nature. Warner Bros. v. American Broadcasting Cos., 720 F.2d 231 (2d Cir. 1983). *But see* Triangle Publications, Inc. v. Knight-Ridder Newspapers, Inc., 621 F.2d 1318 (5th Cir. 1980) (court rejected the notion that advertisements are a form of commercial use per se ineligible for fair use).

If the work is used by a competitor, then the use might not be fair because of an adverse "effect . . . upon the potential market for or value of the copyrighted work." 1976 Act, *supra* note 32, at § 107(4). Thus, in a case where defendant put on a play that used substantial portions of the novel *Gone With The Wind*, the court held that the overall intent of both was to entertain: "[F]air use cannot be applied to 'Scarlett Fever' because its function is identical to the functions of the film 'Gone With The Wind' and the novel *Gone With The Wind*. . . ." Metro Goldwyn-Mayer v. Showcase Atlanta Co-op. Prod., 479 F. Supp. 351 (N.D. Ga. 1979). *See also* 3 M. NIMMER, *supra* note 57 at § 13.05[B] ("If both the plaintiff's and the defendant's works are used for the same purpose, then under the functional test the defense of fair use should not be available since the defendant's work serves the same function as that of the plaintiff's.").

61. "It is, nevertheless, true that copyright protection is narrower, and the corresponding application of the fair use defense greater, in the case of factual works than in the case of works of fiction or fantasy." 3 M. NIMMER, *supra* note 57, at § 13.05[A][2]. *See* Harper & Row, Publishers v. Nation Enterprises, 471 U.S. 539, 563 (1985). *See also* Dow Jones & Co. v. Bd. of Trade, 546 F. Supp. 113, 120 (S.D.N.Y. 1982) ("[C]ompilations of factual material . . . should be most conducive to fair use. Authors of compilations, therefore, must be held to grant broader licenses for subsequent use than persons whose work is truly creative.").

62. 33 U.S. 591 (1834).

63. M. NIMMER, CASES AND MATERIALS ON COPYRIGHT 37 (2d ed. 1979).

64. *Wheaton*, 33 U.S. (8 Pet.) at 593-95.

> written opinions delivered by this court; and that the judges thereof cannot confer on any reporter any such right.[65]

The case was sent back to the circuit court to see if Mr. Wheaton had complied with the statutes in full, since his marginal notes were properly copyrightable.[66] The acrimonious dispute was settled years later.[67]

The holding seems clear enough: judicial opinions are not copyrightable. This concept has been applied to government publications, as can be seen in various acts[68] up to the 1976 Act.[69]

But the rationale behind the decision is just as important. A copyright monopoly is not for the benefit of the author; it is for the benefit of the public.[70] Copyright monopolies are not gestures of gratitude: authors are rewarded in order to motivate them to create more works.[71] A judge is already duty-bound to render opinions, so financial reward through copyright will not promote more opinions.[72] Recent copyright decisions echo *Wheaton*,[73] and this idea is the "cornerstone" of copyright to

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65. *Id.* at 668.

66. *See* Callaghan v. Myers, 128 U.S. 617, 649-50 (N.D.Ill. 1888) taken from Gray v. Russell, 1 Story 11 (1839). Justice Story said:

> [I]t was held, that the opinions of the court, being published under the authority of Congress, were not the proper subject of private copyright. But it was as little doubted by the court, that Mr. Wheaton had a copyright in his own marginal notes, and in the arguments of counsel as prepared and arranged in his work. [Remanding the case to the Circuit Court] would have been wholly useless and nugatory, unless Mr. Wheaton's marginal notes and abstracts of argument could have been the subject of a copyright. . . ."

Callaghan, 128 U.S. at 649-50.

67. "Before the appeal could be heard. . . both of the principal parties had died: Wheaton, on March 11, 1848, and Peters, less than two months later, on May 2, 1848. Ultimately, their estates settled the litigation for a mere $400 in 1850." C. Joyce, *The Rise of the Supreme Court Reporter: An Institutional Perspective on Marshall Court Ascendancy*, 83 MICH. L. REV. 1291, 1385 (1985).

68. Printing Law of 1895, 28 Stat. 608 (1895) (codified at 44 U.S.C. § 505 (1976)) (no copyright in government publications).

69. 1976 Act, *supra* note 30, at § 105. *Cf.* The Copyright Act of 1909, 17 U.S.C. § 8 (repealed 1978): "No copyright shall subsist in . . . any publication of the United States Government, or any reprint in whole or in part thereof. . . ." *Id.*

70. Joyce, *supra* note 67, at 1386-87.

71. U.S. CONST. art I, § 8, cl. 8. Copyright "promotes the . . .useful Arts." *Id.*

72. *See infra* note 97 and accompanying text. Allowing copyright for opinions would be to reward judges for their judicial labors.

73. The monopoly privileges that Congress may authorize are neither unlimited nor primarily designed to provide a special private benefit. Rather, the limited grant is a means by which an important public purpose may be achieved. It is intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the

this day.[74]

B. *Callaghan v. Myers*: Infringement Based on an Older Standard

Myers, the plaintiff, owned the copyright to "Illinois Reports," volumes of reports of the Supreme Court of Illinois that had been compiled by the official reporter.[75] After negotiations concerning the sale of Myers' copyright broke down, Callaghan published a set of reporters anyway.[76] Callaghan defended the action based on the "broad proposition" that law reports are public property and not susceptible of private ownership,[77] and that the official reporter was not an "author" within the meaning of Congress.[78] The court, after addressing lengthy procedural problems of publication and notice, ruled that the arrangement of the volumes was copyrightable and Callaghan had infringed.[79]

First, Callaghan insisted that the headnotes were not protected since all he did was abridge Myers' facts into clearer form.[80] Second, Callaghan claimed that the arrangement of cases was not protected since the system used was "as old as the system of law-reporting."[81] As to the different volumes, Callaghan claimed chance alone governed the selection of cases.[82] Finally, the paging lacked originality since the printed page number is the labor of the printer.[83]

The Supreme Court adopted the circuit court opinion of Judge Drummond on the question of infringement. Judge Drummond found substantial similarity and infringement,

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products of their genius after the limited period of exclusive control has expired.

Sony Corp. v. Universal City Studios, 464 U.S. 417, 429 (1984).

74. "The basic premise of the Court's opinion — that copyright is a monopoly recognized by law primarily for the benefit of the public rather than the author, and is therefore attended by appropriate limitations and conditions — has remained the cornerstone of construction in this field down to the present day." Joyce, *supra* note 67, at 1387.

75. *Callaghan*, 128 U.S. at 619.

76. *Id.* at 622.

77. *Id.* at 645.

78. *Id.* at 646-47.

79. *Id.* at 667.

80. *Id.* at 640-41.

81. *Id.* at 641.

82. *Id.*

83. *Id.*

based almost wholly on the headnotes.[84] Judge Drummond placed great weight on the fact that Callaghan had copied the mistakes of Myers in compiling the volumes.[85] But when it came to page numbers, Judge Drummond said:

> The fact appears to be . . . that in arranging the order of cases, and in the paging of the different volumes, [Myers'] edition has been followed by the defendants; but, while this is so, I should not feel inclined . . . to give a decree to plaintiff . . . . [T]he arrangement of cases and the paging of the volumes is a labor inconsiderable in itself, and I regard it, not as an independent matter, but in connection with other similarities . . . .[86]

Thus, without Callaghan's wholesale copying of Myers' headnotes and the "smoking gun" of copying Myers' mistakes in the actual opinions, the arrangement would not have been infringed, and more importantly for *West v. MDC*, the pagination would not have been probative of infringement.

It is important to note the differences between the 1976 Act and the underlying copyright statute in *Callaghan*. The statute upon which the Supreme Court in *Callaghan* relied was the Act of February 3, 1831, chapter 16.[87] Unlike the 1976 Act, the statute is devoid of any references to originality, compilations, arrangement, coordination, or selection.[88] Labor, talent, and judgment was the standard at the time.[89] This standard emphasizes the actions of the compiler, not the nature of the resulting work. The key inquiry under the 1976 Act is not whether the person sweat and labored while compiling, but whether the resulting work is original.[90] "Labor" suggests that the work must be the product of hard work, but the amount of effort is not an element of copyright today.[91] In addition, "talent" suggests cre-

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84. *Id.* at 659-61.

85. *Id.* at 662.

86. *Id.* at 661-62.

87. Act of Feb. 3, 1831, ch. 16, 4 Stat. 436 (1831). *See Callaghan*, 128 U.S. at 651.

88. [A]ny person or persons . . . who shall be the author or authors of any book or books, map, chart, or musical composition, . . . or who shall invent, design, etch, engrave [or] work . . . from his own design, any print or engraving . . . shall have the sole right and liberty of printing, reprinting, publishing, and vending . . . for the term of twenty-eight years.

Act of February 3, 1831, ch. 16, 4 Stat. 436 (1831). The next sixteen sections concern notice, publication, recording, and fees, with no description of the scope of the copyright.

89. *Callaghan*, 128 U.S. at 662.

90. 1976 Act, *supra* note 32, at § 102. *See supra* note 50.

91. *See supra* note 50 and accompanying text.

ativity, which again has nothing to do with copyright today.[92]

C. *Banks v. Manchester*: Reaffirming *Wheaton's* Rationale

Banks v. Manchester was decided November 19, 1888 — one month before *Callaghan*.[93] An Ohio statute permitted the official reporter of the Supreme Court of Ohio to obtain a copyright in the opinions he published. Plaintiff Banks, the official reporter of Ohio, sought an injunction under the statute perpetually restraining defendant from printing and publishing decisions.[94] The Supreme Court assumed that the opinions, the statements of the case, and the syllabuses or headnotes were exclusively the work of the judges for purposes of the action.[95]

Mr. Justice Blatchford, again delivering the opinion of the court as in *Callaghan*, determined that the statute was unconstitutional in light of *Wheaton*: "In no proper sense can the judge who, in his judicial capacity, prepares the opinion or decision, the statement of the case and the syllabus or headnote, be regarded as their author or proprietor. . . ."[96] In accord with *Wheaton*, judges can have no copyright in "the fruits of their judicial labors,"[97] whether the fruits are headnotes or opinions.

D. *Banks Law Pub. Co. v. The Lawyers' Co-operative Publishing Co.*: No Infringement for Star Pagination

Banks, official reporter of the Supreme Court, sued Lawyers' Co-operative for infringement arising out of the arrangement of cases, the division into volumes, the table of cases, and pinpoint citation.[98] The Second Circuit, in a per curiam opinion, adopted the opinion of Judge Hazel of the Southern District of New York[99] and found no infringement. The court only added two sentences:

> It is not necessary to discuss so much of the opinion below as deals with the questions of assignment and of the right of the official reporter to secure copyrights. We concur with Judge Hazel in his reasoning and conclusion that the arrangement of

92. *See supra* note 49 and accompanying text.
93. 128 U.S. 244 (1888). *Callaghan* was decided December 17, 1888. *Id.* at 617.
94. Banks v. Manchester, 128 U.S. at 249.
95. *Id.* at 251.
96. *Id.* at 253.
97. *Id.*
98. Banks Law Publishing Co. v. The Lawyers' Co-operative Publishing Co., 169 F. 386 (2d Cir. 1909).
99. *Id.*

> reported cases in sequence, their paging and distribution into volumes, are not features of such importance as to entitle the reporter to copyright protection of such details.[100]

It is fitting to note that the court weighs the relative importance of the features, while the standard today is originality.[101] The Act of March 3, 1905, the applicable law, did not mention originality or arrangement.[102]

Judge Hazel's opinion, adopted by the Second Circuit, demonstrates that Banks' status as official reporter was important in finding lack of copyrightability.[103] But the opinion also contains this language directly on point for the dispute in *West v. MDC*:

> No authority is cited which supports the contention that complainant (Banks) is entitled to be protected in its pagination and arrangement of cases where the substance of the origination is not pirated, and in the absence of such authority I hesitate to hold that the scope of the copyright act protects the reporter. . . .[104]

While Banks arguably lost the case because of his status as official reporter, this language suggests that Banks would have lost anyway, as the defendant would not have infringed by copying the pagination.

IV
West v. MDC

A. The District Court's Opinion

The district court granted West a preliminary injunction based on the substantial likelihood that West's case arrangements are protected by copyright, and MDC's copying of West's page numbers constitutes infringement.[105]

Two cases, *Callaghan* and *Banks*, were of "particular interest and importance in providing an analytic framework in which to consider the claims of the parties."[106] The district court also undertook a "fair use" analysis,[107] finding the use unfair.[108] Fi-

100. *Id.* at 391.
101. *See supra* notes 47-50 and accompanying text.
102. Act of March 3, 1905, ch. 1432, 33 Stat. 1000 (1905) (repealed 1909).
103. *Banks*, 169 F. at 387-88.
104. *Id.* at 390.
105. *West*, 616 F. Supp. 1571.
106. *Id.* at 1575-76.
107. *Id.* at 1580-81.

nally, the district court addressed the public interest and found it favored West.[109]

1. *The District Court's Interpretation of* Callaghan

The district court placed great weight on this passage from *Callaghan*:

> Such work of the reporter, which may be the lawful subject of copyright, comprehends . . . the *order of arrangement of the cases, the division of the reports into volumes, the numbering and paging of the volumes*, the table of cases cited in the opinions, (where such table is made), and the subdivision of the index into appropriate, condensed titles, involving the distribution of the subjects of the various headnotes, and cross-references, where such exist.[110]

The district court said this passage "specifically delineated the copyrightable portions of the law reports."[111]

The district court also said that West's arrangement met "the Supreme Court's *Callaghan* test of labor, talent and judgment."[112] The district court was impressed with the effort West undertakes:

> West collects cases from every state and federal court in this country. West does not then simply take any cases it has on hand, put them together in any order, and bind them in a hardback volume. They first separate state court decisions from federal court decisions. The state court decisions are further subdivided into regions and placed in a regional reporter appropriate for the case in question. The federal decisions are divided at the district court and appellate court level. District court decisions are further subdivided according to the subject matter of the decision be they bankruptcy, federal rules or other miscellaneous matter. This comprehensive process involves considerable planning, labor, talent, and judgment on West's part.[113]

The district court's reading of *Callaghan* fails to take into account the portion of Judge Drummond's opinion regarding page numbers.[114] Judge Drummond expressed doubts about the ability of page numbers to be copyrighted, stating that page

108. *Id.*
109. *Id.* at 1582-83.
110. *Callaghan*, 128 U.S. at 649 (emphasis added by the district court).
111. *West*, 616 F. Supp. at 1576.
112. *Id.* at 1576.
113. *Id.*
114. *See supra* note 86 and accompanying text.

number copying is not an "independent matter," but one that must be viewed in "connection with other similarities."[115] At best, the *Callaghan* court recognized the possibility of page numbers being within a copyright,[116] but decided to adhere to Judge Drummond's view.[117]

In addition, *Callaghan* was based upon the older standard of "labor, talent and judgment."[118] The district court failed to note this, instead applying an outdated standard.[119]

2. *The District Court's Interpretation of* Banks

Banks said that mere pagination and arrangement do not justify copyright protection, but the court further held that an official reporter could not have a copyright according to *Wheaton*.[120] The district court found "that MDC, in relying upon *Banks*, has chosen a fragile bark upon which to sail the rocky shoals of copyright law."[121] *Banks*' discussion of pagination is not probative, according to the district court, because the court did not come out and say, "We hold that copyright protection may not be had for printed arrangement and pagination."[122]

The district court attributed the lack of an unequivocal statement to "the inherent nature of printing when one is mandated to officially record a court's decision."[123] Copyright is not given to official reporters because the activity of collating, arranging and numbering "is not an exercise of independent judgment or discretion."[124] Pagination "inhere[s] in the official process and become[s] part of the public domain."[125] When a person is required to perform those acts by law, "those labors do not reflect any independent judgment or discretion and as such become part of the public domain."[126] West, on the other hand, compiles cases "of its own initiative expending considerable labor,

115. *Id.*
116. *Callaghan*, 128 U.S. at 649.
117. *Id.* at 661-62.
118. *West*, 616 F. Supp. at 1576. *See also supra* notes 87-92 and accompanying text.
119. *West*, 616 F. Supp. at 1576. *See infra* note 159 and accompanying text.
120. 169 F. 386 (2d Cir. 1909). *See supra* notes 99-104 and accompanying text.
121. *West*, 616 F. Supp. at 1577.
122. *Id.*
123. *Id.*
124. *Id.*
125. *Id.*
126. *Id.*

talent and judgment in the process."[127]

The district court's view of *Banks* in particular and official reporters in general is curious. First, *Wheaton* held that judges and official reporters could not get a copyright in opinions not because judges fail to expend a fair amount of originality, but because copyright is for the public first, authors second.[128] Copyright is granted to authors so that the financial benefits of publication will prompt them to write more, and the public benefits from a large body of written works.[129] Since judges are instruments of the state who are required to render opinions, granting a copyright would not motivate them to write more opinions.[130] Similarly, official reporters are acting on behalf of the judges, and thus they do not get a copyright in the compilation for the same reason: they are duty bound to compile the cases anyway. The district court essentially states that if West compiles the cases the work is original, but if the official reporter compiles the cases in an identical manner the resulting work is not original because the official reporter is employed by the state.[131]

This interpretation of *Banks* is strained: surely official reporters exercise just as much independent judgment and discretion as non-official reporters.[132] The court in *Banks* was extending the rationale of *Wheaton*: no copyright for an official reporter. The explicit language on page numbers can only mean that if *Banks* was not the official reporter, the court still might not have found infringement because pagination is simply not enough.[133]

3. *The Fair Use Analysis*

After finding that the page numbers were protected by copyright, the district court undertook a fair use analysis.[134] First it found that the purpose and character of MDC's use was com-

127. *Id.*

128. Wheaton v. Peters, 33 U.S. (8 Pet.) 591 (1834). *See also supra* notes 62-85 and accompanying text.

129. *Wheaton*, 33 U.S. (8 Pet.) 591 (1834).

130. Copyright motivates through reward. *See supra* notes 70-74.

131. *West*, 616 F. Supp. at 1577.

132. The circuit court said, "We agree with MDC that the reporter in *Banks* exercised independent judgment." *West*, 799 F.2d at 1225-26.

133. *See* discussion of *Banks*, *supra* notes 98-104 and accompanying text.

134. *West*, 616 F. Supp. at 1580.

mercial, intended for profit.[135] This weighed heavily against MDC.[136] Second, the nature of the copyrighted work was found to be noncreative as opposed to creative.[137] This weighed against West. Third, MDC had used a substantial amount of the work.[138] Notwithstanding that page numbers make up a miniscule portion of a West reporter, "[w]hen viewed in light of MDC's intent and ability to expropriate each and every page number from each and every volume of West's reporters, the appropriation takes on a greater magnitude. . . .[T]his 'small amount' is the key to the West arrangement."[139] This weighed against MDC.[140] Finally, the effect of the infringing use on the market was found to be great. Both works, LEXIS and West's reporters, are used for the same purpose and fulfill the same function.[141] The district court said, "There can be little doubt that MDC's incorporation of West's page numbers into the LEXIS reports database will supersede a substantial use of West's hard bound volumes of reporters."[142] The district court said that "MDC's star pagination may do away with the need for West's reporters. . . ."[143] This weighed against MDC, too. Thus, the district court properly concluded that MDC's use of West's page numbers would not be fair.

4. *Public Interest*

The court recognized that the constitution "intended to motivate creative activity by the provision of a special reward, and eventually allows the public total access to the products of [an author's] genius after the limited period of exclusive control has expired."[144] Without economic incentive, West would not compile and arrange reporters. The fact that "star pagination would give judges, lawyers and citizens freer access to the entire body of law" is immaterial.[145] Reducing copyright protection to works of public import would create an economic

135. *Id.*
136. *Id. See also supra* note 56 and accompanying text.
137. *West*, 616 F. Supp. at 1580.
138. *Id.* at 1581.
139. *Id.*
140. *Id.*
141. *Id.*
142. *Id.*
143. *Id.* at 1582-83.
144. *Id.* at 1582.
145. *Id.*

disincentive to create works of public import.[146] The public interest mandates that MDC's star pagination be restrained.[147]

The district court was correct in recognizing the underlying goals of copyright, but was incorrect in framing the issue. The issue is not whether a "public import" exception should be made: clearly this is contrary to copyright law.[148] Nor is the issue whether star pagination gives citizens "freer access" to cases: because all the cases are in LEXIS' database, persons have access to them even without star pagination.[149] The issue really is whether LEXIS users can have references to volumes where the exact words of the opinions on the screen can be found, enabling them to guide others to the exact words in those volumes.

B. The Eighth Circuit's Opinion

1. *West's Arrangement Was Protected by Copyright*

The Eighth Circuit affirmed the district court in an opinion by Judge Arnold.[150] The court noted that the 1976 Act protects "original works of authorship,"[151] which must be the product of some "creative, intellectual or aesthetic labor,"[152] no matter how slight. West's reporters, as "compilations" under the 1976 Act, are copyrightable.[153] "An arrangement of opinions in a case reporter, no less than a compilation and arrangement of Shakespeare's sonnets, can qualify for copyright protection."[154]

The court found support for its position in *Callaghan*.[155] While they recognized that "[t]he teaching of *Callaghan* with respect to the issues before us does not come through with unmistakable clarity,"[156] the court found that *Callaghan* does not establish a per se rule against arrangement of case reporters.[157]

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146. *Id.*

147. *Id.*

148. *See supra* note 48 (refutation of view that a work must have some objective value to be subject to copyright).

149. As the Eighth Circuit pointed out, access is not a problem since MDC itself reports the decisions on LEXIS. *West*, 799 F.2d at 1229.

150. *West*, 799 F.2d at 1219.

151. *Id.* at 1223, *citing* 1976 Act, *supra* note 30, at § 102(a).

152. *West*, 799 F.2d at 1223.

153. *Id.* at 1224.

154. *Id.*

155. *Id.*

156. *Id.* at 1225.

157. As MDC points out, the treatment of case arrangement and pagination in *Callaghan* was not crucial to the Court's decision, since the defendants had

The court then disagreed with MDC that *Banks* established a per se rule against copyright in the arrangement of cases. [158] The court found that *Banks* was based on the status of the official reporter, and in any event should not be given "full force" because it was based on an older standard and was only a circuit opinion.[159] The court did find, contrary to the district court, that the reporter in *Banks* exercised independent judgment.[160]

The court found that West was not an "official reporter" within the meaning of *Wheaton* and *Banks*, because West is not bound by statute to create reporters.[161] The court concluded, "as did the District Court, that the arrangement West produces through this process is the result of considerable labor, talent, and judgment."[162] The court also found that West's case arrangements "easily" met the originality requirement of the 1976 Act.[163] Thus the arrangement of cases was subject to copyright,[164] and the tougher question of whether the page numbers were within this arrangement was then addressed.

2. *MDC's Use of West's Page Numbers Constituted Infringement of West's Copyright in the Arrangement of Cases*

The court found that use of the page numbers infringed on

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also made use of other portions of Myers's volumes, such as headnotes and statements of facts. . . . But as we read it, *Callaghan* establishes at least that there is no per se rule excluding case arrangement from copyright protection, and that instead, in each case the arrangement must be evaluated in light of the originality and intellectual-creation standards.

Id. at 1224-25.

158. *Id.* at 1225.

159. *Id.* at 1226.

160. *Id.* at 1225-26.

161. *Id.* at 1226.

162. *Id.* This older standard of labor, talent and judgment was also cited by the district court. *See supra* note 127 and accompanying text. This standard fails to meet current copyright standards. "Labor" suggests that the amount of effort involved is relevant, and "talent" suggests some artistic standard, when it is clear that the artistic merits of the work have nothing to do with copyright. *See supra* notes 48-49 and accompanying text. Finally, "judgment" does seem consistent with the current act, insofar as no objective standard of the correctness of the judgment is imposed.

The correct inquiry under the 1976 Act is whether the collection and assembly of preexisting material is selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. 1976 Act, *supra* note 32, at § 101; *see also supra* note 50 and accompanying text. The court ultimately did use this criteria, but only after giving credence to the labor, talent and judgment standard. *See supra* note 62.

163. *West*, 799 F.2d at 1227.

164. *Id.*

the copyright.[165] The court said, "The key to this case, then, is not whether numbers are copyrightable, but whether the copyright on the books as a whole is infringed by the unauthorized appropriation of these particular numbers."[166] The copyright recognized was "in West's arrangement, not in its numbering system; MDC's use of West's page numbers is problematic because it infringes West's copyrighted arrangement, not because the numbers themselves are copyrighted."[167]

Star pagination would "permit LEXIS users to view the arrangement of cases in every volume of West's National Reporter System."[168] Pinpoint cites to West's volumes infringe because they allow LEXIS users to discern the precise location in West's arrangement of the portion of the opinion being viewed.[169] With star pagination, no one would need West's reporters to get every aspect of West's arrangement.[170] Knowledge of the location of opinions and parts of opinions within West's arrangement is a large part of the reason one would purchase West's volumes.[171]

The court rejected MDC's claim that repeating the page numbers was permissible because it merely stated pure fact. An isolated use of factual aspects of a compilation is permissible, the court said, but when multiplied many times it resulted in wholesale appropriation.[172]

C. Judge Oliver's Opinion

Judge Oliver concurred with the majority's procedural analysis of the case, but dissented from the copyright analysis as being inconsistent with applicable law.[173] According to Judge Oliver, the issues should have been resolved under the principles of *Wheaton*, *Banks*, and *Callaghan*.[174]

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165. *Id.*
166. *Id.*
167. *Id.* at 1228.
168. *Id.* at 1227.
169. *Id.*
170. *Id.* at 1228.
171. *Id.*
172. *Id.*
173. *Id.* at 1230.
174. *Id.*

1. *Pagination Might Not Even Come Under Copyright Protection of a Volume*

Judge Oliver noted that the record did not support the facts upon which the district court and majority opinions were based.[175] For example, West has no general copyright on its "National Reporter System;" each separate volume carries its own copyright. Very few Certificates of Copyright Registration were in the record, and no certificates for state court opinions were in the record.[176] Furthermore, none of the certificates showed that West claimed a copyright in the page numbers. The registration form required a "brief, general statement of the material that has been added to this work and in which copyright is claimed," and West's answer stated: "[C]ompilation of previously published case reports including but not limited to opinions, synopses, syllabi or case law paragraphs, key number classifications, tables and index digest, with revisions and additions."[177]

Finally, although page numbers are an important part of the arrangement, as the majority pointed out,[178] this does not justify finding that they are subject to copyright. Titles are important parts of a copyrighted volume, too, but it is beyond dispute that titles are not subject to copyright.[179] "All parts of a copyrighted volume may not be automatically considered a subject to copyright simply because a publisher claims a copyright on the whole volume."[180]

Even assuming that West's pagination is entitled to copyright protection as an important part of the arrangement, Judge Oliver did not believe that star pagination infringed West's arrangement in any way.[181] Law book publishers in the United

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175. *Id.* at 1233.

176. *Id.* Only twelve certificates were in the record, and all concerned lower federal court decisions. *Id.* at 1233 n.10.

Registration of copyright, while not a condition of copyright protection, nevertheless is required for certain remedies for infringement. 1976 Act, *supra* note 32, at §§ 405, 408, and 412.

177. *West*, 799 F.2d at 1233-34. Although *West* did not mention page numbers, the language "including but not limited to" means that the list was not comprehensive.

178. *Id.* at 1227.

179. Id. at 1234. *See* 1 M. NIMMER, NIMMER ON COPYRIGHT § 2.16 at 2-186 (1987); Duff v. The Kansas City Star, 299 F.2d 320, 323-24 (8th Cir. 1962).

180. *West*, 799 F.2d at 1234.

181. *Id.*

States have a long tradition of star pagination.[182] In addition, current literary practice suggests that citations to compilations of poetry are not an infringement upon such arrangements.[183]

2. *Factual Determinations of the Originality of the Page Numbers Were Necessary*

Judge Oliver disagreed with the district court that "West's page numbers and its arrangement of cases are *necessarily* within the scope of copyright protection."[184] The record does not show how or by whom West's page numbers are, in fact, created.[185] How the page numbers are assigned is a "total mystery."[186] The process by which pages are numbered is an open question that must be determined at trial. If the pagination is nothing more than an "electronic response to a direction given a machine" then the originality standard may not be met.[187] In addition, it would be "inconceivable . . . that the public policy that denies all right of copyright to a court opinion would nevertheless grant copyright to the page numbers of the volume in which such a court opinion is published."[188]

3. *The Majority and the District Court Misinterpreted the Case Law*

According to Judge Oliver, both the district court and the majority misinterpreted the pertinent case law, particularly *Callaghan* and *Banks*.[189] In addition, the majority failed to discuss the leading case, *Wheaton*, in detail, and did not even mention *Manchester*.[190] For Judge Oliver, the three Supreme Court cases are the starting point,[191] and the principle of law stated and applied in all three is the same: on the basis of public pol-

182. "MDC intends to do no more than what other law book publishers have been doing for a long, long period of time." *Id.* at 1235.

183. *Id.* Judge Oliver points out that Bartlett's *Familiar Quotations* gives jump cites to the lines, the scenes and the acts of Shakespeare's plays as earlier published by the Oxford University Press. Had Bartlett included page numbers, Judge Oliver doubts that the addition would constitute an infringement of the arrangement. *Id.* at 1235 n.18.

184. *Id.* at 1237 (emphasis in original).

185. *Id.*

186. *Id.*

187. *Id.*

188. *Id.*

189. *Id.* at 1238.

190. *Id.* at 1242.

191. *Id.*

icy, the Court could allow no impediment to the fullest possible dissemination of its judgments.[192] If pagination had been at issue in any of the cases, "the Court would not have hesitated to hold that star pagination in a volume of published law reports would not be subject to copyright."[193]

According to Judge Oliver, *Wheaton* held that opinions were not copyrightable on the basis of public policy, but explicitly remanded for headnotes.[194] *Manchester* held that even headnotes, if written by judges, were not copyrightable for the same policy reasons as in *Wheaton*.[195] *Callaghan* held that directly copying headnotes not written by a judge was infringement, but mentioned that page numbers alone would not have sufficed.[196] Finally, the only court that considered the precise issue of star pagination, the Second Circuit in *Banks*, explicitly stated that page numbers would not be enough.[197]

Thus, Judge Oliver concluded that the majority and the district court misinterpreted the case law, improperly finding that star pagination infringed West's copyright.

D. Comments

Judge Oliver's opinion is superior to both the district court's and the majority's. He essentially makes three points: (1) the statutory standard of originality was not shown; (2) the majority and the district court misinterpreted the case law and its underlying public policy; and (3) star pagination has a long tradition in both legal case reporters and literature.

First, Judge Oliver was correct in pointing out that the district court and the majority had not satisfactorily addressed the correct legal standard of originality. The issue of whether the page numbers are original, that is, originating with the author, is a simple question but never addressed. If the printer, not West, gave the pages their numbers then originality might not

192. *Id.* at 1245. *See also id.* at 1242 (citing Joyce, *supra* note 67, at 1390).

193. *West*, 799 F.2d at 1245.

194. *Id.* at 1240-45.

195. *Id.* at 1242-43; *see also* discussion of Banks v. Manchester, *supra* notes 93-97 and accompanying text.

196. *West*, 799 F.2d at 1242-44; *see also* discussion of *Callaghan*, *supra* notes 75-92 and accompanying text.

197. *West*, 799 F.2d at 1245-46; *see Banks*, 169 F. at 390. Note that the per curiam opinion explicitly declines to base its affirmation on the official status of the reporter. *Id.*

be present.[198] Also, if the numbers were not "selected, coordinated, or arranged" because the cases were sequential, they fail to meet the explicit language of the 1976 Act.[199] Both questions of fact should be addressed at trial.

Second, Judge Oliver is correct about *Wheaton*. *Wheaton's* underlying rationale echoes the Constitution: copyright protection must be given to benefit the public.[200] Judicial opinions are in the public domain because the public has a strong interest in having access to them. In addition, judges are duty-bound to create the opinions, and the financial incentives of copyright will not promote the creation of more opinions.[201] Since the financial incentive of copyright is only given to promote the creation of more works, the courts should examine whether preventing star pagination promotes or hinders the dissemination of legal opinions in case reporters and computer databases. By framing the issue in this way, both West's and MDC's interests can be weighed against the public good.

Third, Judge Oliver's observation that star pagination has been around a long time is helpful. Star pagination has traditionally been used in the legal profession and in literature. It is an important device for research. Pinpoint cites to accepted volumes add clarity to legal briefs and literary articles. Any decision that could very well end this tradition should be carefully made on undisputed facts.

V
Remedying the Result in *West*

A. Three Solutions

MDC, and star pagination in general, were dealt a harsh blow by the Eighth Circuit. There are three possible ways for the result in *West v. MDC* to be remedied. First, legislative amendments to the 1976 Act could ensure star pagination.[202] Second, the courts could take a different approach than the Eighth Circuit and find that page numbers are not within the scope of copyright.[203] Finally, MDC has other options for over-

198. *See supra* notes 49-50 and accompanying text.
199. 1976 Act, *supra* note 32, at § 101.
200. *See supra* notes 62-74 and accompanying text.
201. *See supra* notes 70-74 and accompanying text.
202. *See infra* notes 207-13 and accompanying text.
203. *See infra* notes 214-20 and accompanying text.

coming the decision, such as using what is in the public domain, making up their own page numbers for LEXIS, or simply paying West for use of the numbers.[204]

B. Statutory Amendment

Congress could expressly allow page numbers of copyrighted works to be used by others. The 1976 Act itself contains two fitting methods for allowing the use of otherwise copyrightable material: (1) expressly exempt the use;[205]or (2) require that compulsory licenses be granted for the use, in the event that no license can be negotiated.[206]

1. *Exempt Page Numbers From Infringement*

Congress could simply make the appropriation of another's copyrighted page numbers exempt from infringement actions if used for the purposes of star pagination. The 1976 Act exempts certain uses from copyright actions.[207] For example, performances of a copyrighted work in non-profit educational institutions, in religious institutions, or in the home are exempt.[208]

Unlike a licensing amendment,[209] this approach imposes no financial restraints at all on star pagination. If the goal of legislation is simply to let the public have star pagination, then exemption succeeds.

2. *Compulsory License*

A second possible amendment would allow persons who want to use page numbers to obtain a compulsory license.[210] Using the facts at hand, MDC could negotiate with West for a license enabling MDC to use West's page numbers. If West and MDC were unable to negotiate a fair deal, MDC could compel West to grant a license. This compulsory license still would allow West to receive royalties at a rate fixed by the Act.[211] Even if a copy-

204. *See infra* notes 224-33 and accompanying text.
205. *See* 1976 Act, *supra* note 32, at § 110.
206. *See* 1976 Act, *supra* note 32, at §§ 111, 115.
207. 1976 Act, *supra* note 32, at § 110.
208. *Id.*
209. *See infra* notes 210-13 and accompanying text.
210. *See, e.g,* 1976 Act, *supra* note 32, at § 111 (c), (d) (compelling licensing for secondary transmissions by cable systems); *id.* § 115 (compelling licensing for nondramatic musical works).
211. *Id.* § 115. For example, this section allows a musician to do a version of an-

right holder objects to the use of the work, the public interest is served by compelling a license for such use.

The good thing about licensing is that three sides win: West, whose original efforts are rewarded financially to some degree;[212] MDC, since LEXIS can now compete with the volumes and Westlaw; and the public, which gets star pagination on LEXIS, a real choice between Westlaw and LEXIS, and lower prices through competition.[213] This alternative seems to be the best.

C. Judicial Relief

Another way for the decision to be changed is through the courts. The case has been sent down to be tried on the facts, and MDC might win on the merits.[214] Even if MDC does not win, MDC could appeal to the Eighth Circuit again.[215] With a complete record and facts sufficient to support his separate opinion, Judge Oliver might be able persuade his fellow judges that the copyright for arrangement should not include West's page numbers.[216] Short of that unlikely turn of events, the only court available for review would be the Supreme Court of the United States, which has denied certiorari once already.[217]

After the case is re-tried in the Eighth Circuit, the Supreme Court could grant certiorari and adopt the reasoning of Judge Oliver.[218] The Court could emphasize the holding and policy underpinnings of *Wheaton*, and find that the intent of the Constitution was to benefit the public.[219]

While judicial action might be the quickest way to prevent copyright from being extended to include the page numbers of a compilation, the chances of this occuring seem remote at best.

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other's song provided that the "fundamental character of the work" or integrity of the work is not altered. *Id.* § (a)(2).

212. Of course, if West's future is threatened, *see infra* note 234, then the compulsory license is inadequate.

213. *See infra* note 223 and accompanying text (discussion of the cost of LEXIS).

214. Given the disposition of the district court, *see supra* notes 105-49 and accompanying text, they will probably hold for West.

215. *West*, 799 F.2d at 1229.

216. *See supra* notes 173-89 and accompanying text (discussion of Judge Oliver's separate opinion).

217. 107 S. Ct. 962 (1987).

218. *See supra* notes 173-89 and accompanying text (discussion of Judge Oliver's opinion).

219. *See supra* notes 70-74 and accompanying text.

D. MDC's Other Options

MDC wants to use West's page numbers because star pagination is economically beneficial. Computer-assisted research already has a big advantage over volumes in that it is much quicker to find cases in a database than by paging through volumes. If LEXIS has pinpoint cites the advantage over volumes is even greater. It is possible, as the Eighth Circuit noted, that no one would need West's reporters anymore.[220]

MDC has three options: (1) negotiate with West for use of the page numbers, paying for the use; (2) use what is available in the public domain; or (3) create a uniform citation form to LEXIS.

1. *Negotiate With West*

West might argue: Why shouldn't MDC pay for using our page numbers? Since the numbers are valuable, perhaps MDC should try to negotiate with West for their use. Arguably, it is only fair that MDC pay for giving LEXIS users access to West's "significant work of skill and enterprise."[221] If MDC's offer is good enough, West might accept. Indeed, this maybe the best way for the two industry giants to resolve this problem.[222]

On the other hand, if West will not deal with MDC then Westlaw has a crucial advantage over LEXIS. Star pagination is so important that it could lead to virtual monopolization of the industry. Competition in the field of computer-assisted legal research is essential for keeping the already high cost down.[223]

2. *Use Page Numbers in the Public Domain*

If West will not sell the rights to the page numbers in their copyrighted case reporters, then MDC should use pinpoints to page numbers in case reporters not protected by copyright. Any

220. "With MDC's star pagination, consumers would no longer need to purchase West's reporters. . . ." *West*, 799 F.2d at 1228.

221. *West*, 616 F. Supp. at 1578.

222. MDC has worked out agreements with The Lawyers' Cooperative Publishing Company, Bancroft-Whitney Company, The Research Institute of America, Inc. and the Shepard's Division of McGraw Hill, Inc. for use of copyrighted materials in LEXIS' Auto-cite and Shepard's Citation Services. *See* LEXIS/NEXIS: Library Contents and Alphabetical List of Files 45 (August 1986) (A Manual for LEXIS Users).

223. LEXIS generally costs between $100 and $200 per hour, depending on the number of searches and modifications.

arrangement done prior to 1921 is in the public domain,[224] so MDC is free to use page numbers from all reporters published before then. MDC could also use the page numbers of the official reporters.[225] For example, the Government Printing Office prints the United States Supreme Court Reports, and MDC would be free to use star pagination for those important volumes.[226]

The negative aspects of this option are obvious. If MDC can only supply star pagination to works in the public domain, a large portion of necessary reporters will be left out.[227] For those in the legal profession, the uncertainty of finding page numbers on LEXIS might make incomplete star pagination worse than no star pagination at all.

3. *Create a Uniform Citation Form To LEXIS*

MDC could create a citation form for LEXIS. One way would be to add their own page numbers to the opinions, and pinpoint cites could be made to those page numbers. Since the initial cite to West volumes is "noninfringing fair use,"[228] one could cite *West v. Mead* as: *West Publishing Co. v. Mead Data Central*, 799 F.2d 1219, Lexis 16. Another way would be to cite to the proper LEXIS command for retrieving the case, such as West W/10 MDC. [229] Finding an exact phrase is easily accom-

224. The 1909 Act allowed two terms of twenty-eight years for a total of fifty-six years. 1909 Act, *supra* note 30, at § 24. The 1976 Act extended copyright terms for works like case reporters (i.e., works for hire) to seventy-five years from date of publication. 1976 Act, *supra* note 32, at § 302(c). The 1976 Act extended the terms for works copyrighted under the 1909 Act by providing a forty-seven year period to works in their first term (copyrighted January 1, 1950 or later) and protecting those works in their second term (copyrighted between December 31, 1921 and December 31, 1949) until seventy-five years after the date of their first publication. *Id.* § 304. Thus all copyrights in the arrangement of case reporters published before December 30, 1921 are deemed to be within the public domain. MDC, therefore, may use star pagination for those particular volumes.

225. Note that West's reporters, though widely cited, are not the official reporters of any court in the United States, as that term refers to one employed by the state. *West*, 799 F.2d at 1226.

226. The 1976 Act expressly provides that works of the United States Government are not subject to copyright. 1976 Act, *supra* note 7, at § 105. *See also supra* note 124.

227. *See supra* note 11 for a list of West's reporters. The number is considerable. Also, other companies have a large stake in the reporter business. For example, Bancroft-Whitney publishes many volumes, including Lawyers' Editions and California Appellate Reports. Those page numbers are similarly protected by copyright.

228. *West*, 799 F.2d at 1222.

229. Finding a case in LEXIS requires access to the correct library acquired by typing in the correct code. LEXIS offeres a variety of libraries: GENFED (for general

plished by entering that phrase (or a portion of the phrase) and having the computer locate it.[230] This feature makes pinpoint cites to a page number virtually obsolete.

There are drawbacks to this option too. MDC would have to put considerable pressure on the industry to adopt such citations as legitimate.[231] Getting the legal profession to agree to a radical change in the acceptable way cases are cited would be extremely difficult; traditions die hard in the law.[232]

Nevertheless, if computer-assisted research is part of the wave of the future, a little foresight now will help MDC later.[233] For this reason, MDC would be wise to create a uni-

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federal cases), ADMRTY (for admiralty cases), BKRPTCY (for bankruptcy cases). It also offers libraries with cases from individual states. A new feature even gives access to LEXIS-UK (for cases originating in Great Britain) and LEXIS-FRANCE (for cases originating in France).

Once in the correct library, the next step is finding the correct file. LEXIS files include US (for cases in the United States), USAPP (for appeals cases), and DIST (for district cases). To locate a particular case one must make a search request. For example, to find *Weinstein v. Eastern Airlines*, 316 F.2d 758, one can enter WEINSTEIN W/10 EASTERN AIRLINES, or 316 PRE/5 758.

230. For example, Judge Oliver said, "The impact of *Wheaton v. Peters*, in my judgment, has been both broad and lasting." In order to find that phrase one would search the GENFED library, USAPP file, for the following: CITE(799 PRE/6 1219) AND "BROAD AND LASTING." Once the case is retrieved, hitting the KWIC button (key-word-in-context) will bring the user the exact phrase. *See, e.g.*, REFERENCE MANUAL 1-18 (1985)(MDC's manual for LEXIS users).

WESTLAW, West's computer-assisted legal research system, has a similar (and somewhat easier) system. Once a case is retrieved, a particular phrase can be found by using the LOCATE feature. *See* WESTLAW REFERENCE MANUAL 8/8 - 8/9 (1985 ed. with 1987 inserts).

231. MDC need not start at the top by trying to convince legislators and courts. If the form were accepted by student-run legal citators, such as *A Uniform System of Citation* or Blue Book (jointly put out by Pennsylvania, Yale, Columbia, and Harvard law schools), MDC would be a long way toward universal acceptance. Other student citators, such as the FCC Citator (Hastings) and the Maroon Book (University of Chicago) offer similar forums for new forms. *See* 6 COMM/ENT L.J. 219 (1983) (FCC Citator); 53 U. CHI. L.J. 1353 (1986) (Maroon Book).

232. On the legal profession's adherence to ancient principles, Chief Justice Holmes said:

> It is revolting to have no better reason for a rule of law than that so it was laid down in the time of Henry IV. It is still more revolting if the grounds upon which is was laid down have vanished long since, and the rule simply persists from blind imitation of the past.

Holmes, *The Path of Law*, 10 HARV. L. REV. 457, 469 (1897).

233. MDC claims that it is "ludicrous" and "absurd" to think that star pagination will do away with the need for West's reporters. *West*, 616 F. Supp. at 1582.

Notwithstanding MDC's claim, the legal publishing field is extremely competitive. Banks Publishing, plaintiff in two of the cases previously discussed at length, is no longer the industry leader it once was. The court in Banks Law Publishing Co. v. Lawyers' Co-operative Publishing Co. commented: "The complainant, the Banks Law

form citation form to LEXIS, and then try to get the legal profession to accept it.

D. Conclusion

The result of *West v. MDC* is unfortunate. Star pagination is desirable not only for the legal profession, but for other professions as well.[234] Star pagination is a helpful and venerated way to direct scholars and readers to an exact page.[235] Star pagination saves time and adds clarity. Thus, discouraging star pagination by extending copyright protection to include page numbers has an immediate, negative effect on the public, contrary to the expressed goal of copyright. Barring a turn of events at trial, LEXIS users will not have pinpoint cites for the foreseeable future. The next time a lawyer or student does research on LEXIS and wants to cite to a particular page in a case, that person will have to look up the same case in West's reporter. Firms, judges, lawyers, paralegals, clerks, and students who use LEXIS will not appreciate the considerable waste of time and money caused by double research. Those individuals who are meant to benefit from copyright, will probably conclude that copyright has indeed been stretched too far.[236]

Publishing Company, is the successor in business of the law book publishers well known to the profession as 'Banks & Bros.,' and which firm assigned to the complainant various copyrights to the United States Reports." 169 F. at 386.

Interestingly, Banks Publishings' fall from dominance might be due in part to Congress' decision in 1922 to expand the duty of the Government Printing Office (G.P.O.) to include the United States Reports previously published by Banks. *See* Act of July 1, 1922, § 225, 42 Stat. 816 (1922) (giving authority to the G.P.O.); *see also* 28 U.S.C. §§ 411, 412 (1952)(codification of authority of the public printer). *Cf.* Act of March 3, 1911, §§ 225-26, 36 Stat. 1152 (1911). ("The reporter shall cause the decisions of the Supreme Court to be printed and published. . . .") West's position as industry leader is by no means guaranteed for the ages.

234. *See West*, 799 F.2d at 1235 n.18 (opinion of Oliver, J.).

235. *Id.* at 1235 ("MDC intends to do no more than what other law book publishers have been doing for a long, long period of time.").

236. Some have already reached a conclusion. *See* 1 M. NIMMER, NIMMER ON COPYRIGHT § 3.03, at 3-14: "Based on that factual posture [the page numbers might have been assigned by a word processor or a printer], this case extends compilation copyright too far." *Id.*